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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,062	01/29/2001	Adrian P. Wise	94100414(EP)USC1X1C1D3 PD	8453

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DISCOVISION ASSOCIATES  
INTELLECTUAL PROPERTY DEVELOPMENT  
2355 MAIN STREET, SUITE 200  
IRVINE, CA 92614

EXAMINER

NGUYEN, DUSTIN

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 07/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/771,062

Applicant(s)

WISE ET AL.

Examiner

Dustin Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

1. Claims 1 – 7 are presented for examination.

***Oath/Declaration***

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:  
It is claiming the domestic priority of application 08/382952 filed on 02/01/1995, which is not the same application as mentioned in the disclosure as 08/382958 [ Amendment filed on 01/29/2001 ].

***Specification***

3. Examiner requests Applicants to update the status of any related applications as mentioned in the specification [ paragraph 1, and amended in amendment filed on 01/29/2001 ].
4. Examiner requests Applicants to point out where in the specification that provides detail support for the claim invention since the specification content is largely described.
5. The abstract of the disclosure is objected to because the abstract is the same for other copending applications and also missing period at the end of the abstract. Correction is required. See MPEP § 608.01(b).

6. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

7. The disclosure is objected to because of the following informalities:

I. Page number errors:

a. pages 16a-16l, pages 24a, 24b

II. Specification errors:

a. Figures 3a(1), 3a(2) - page 17

b. bad typing - pages 36-50

III. Table error:

a. bad typing - table A.11, A.14, A.17.

Appropriate correction is required.

### ***Information Disclosure Statement***

8. Examiner requests Applicants to resubmit Foreign Patent or Published Foreign Patent Application and Other Documents as mentioned in the IDS filed on 01/29/2001 to be considered.

### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of patent No. 6038380 [ hereinafter '380 patent ]. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

As per claims 1-7 of instant application, the '380 patent contains the subject matter claimed in the instant application. Both are claiming common subject matter as follows:

An method for storing data, comprising:

receiving a sequence of data words ...;

splitting the data words ...;

packing the consecutive new data words ...; and

unpacking the data words ....

The claims of '380 patent does not specifically state packing and unpacking data words as described in the claims 1-7 of instant application but it would have been obvious to a person skill in the art to recognize that the two claims are similar because token generator of claims 1-7 in '380 patent perform the same functions of generating data words as the claims of instant application.

***Claim Rejections - 35 USC § 112***

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 1 – 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- A. The following terms lack antecedent basis:

- |      |                               |   |          |
|------|-------------------------------|---|----------|
| I.   | the consecutive new data word | - | claim 1  |
| II.  | the packed new data word      | - | claim 1  |
| III. | the unpacked words            | - | claim 3  |
| IV.  | the expander                  | - | claim 4  |
| V.   | the packed data               | - | claim 5  |
| VI.  | the expanded tokens           | - | claim 6. |

***Claim Rejections - 35 USC § 102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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14. Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Horvath et al. [ US Patent No 5450599 ].

15. As per claim 1, Horvath discloses the invention as claimed including a method of storing data, comprising:

receiving a sequence of data words of a first predetermined width [ col 1, lines 15-25 and lines 37-41; and col 9, lines 32-34 ] and different respective format [ col 1, lines 33-37; and col 10, lines 20-37 ];

splitting the data words of the received sequence to form new data words of a new sequence, the new data words having a second predetermined width [ col 6, lines 63-col 7, lines 3; and col 7, lines 62-col 8, lines 2 ];

packing the consecutive new data words consecutively in a token buffer of a second width without holes between the packed new data words [ col 8, lines 3-24 ]; and

unpacking the data words to reproduce the new sequence of new data words [ claim 14 ].

16. As per claim 2, Horvath discloses writing a block of data from the token buffer to a random access memory device configured to store words of the second width [ col 8, lines 11-14; and col 13, lines 17-18 ].

17. As per claim 3, Horvath discloses expanding out run length code in the unpacked words [ col 6, lines 6-9; and col 7, lines 3-6 ].

18. As per claim 4, Horvath discloses the invention as claimed substantially including an inverse modeler, comprising:

a data unpacker to unpack data words received from an input terminal to a different length format [ col 6, lines 63-col 7, lines 3; and col 7, lines 62-col 8, lines 2 ];

a data expander coupled to the data unpacker [ col 8, lines 3-24 ].

a data padder to pad data tokens received from the expander [ col 4, lines 10-12 ].

### *Claim Rejections - 35 USC § 103*

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 5 – 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horvath et al. [ US Patent No 5,450,599 ], in view of Morrison et al. [ US Patent No 4,985,766 ].

21. As per claim 5, Horvath does not specifically disclose the data expander expands out run length codes into runs of zero followed by a level in the packed data. Morrison discloses the data expander expands out run length codes into runs of zero followed by a level in the packed data [ col 7, lines 40-54 ]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Horvath and Morrison because Morrison's teaching would the fullness of the output buffer may be used to determine the quantisation factor [ Morrison, col 1, lines 33-44 ].



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22. As per claim 6, Morrison discloses the padder pads the last word of the expanded tokens [ col 2, lines 32-35; and col 4, lines 13-15 ].

23. As per claim 7, Morrison discloses the data unpacker deletes data between a flush signal and a block end signal [ col 5, lines 1-47 ].

24. A shortened statutory period for response to this action is set to expire **3 (three) months and 0 (zero) days** from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dustin Nguyen whose telephone number is (703) 305-5321. The examiner can normally be reached on Monday – Friday (8:00 – 5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (703) 308-9678.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directly to the receptionist whose telephone number is (703) 305-3900.

Dustin Nguyen

  
**ZARNI MAUNG**  
**PRIMARY EXAMINER**